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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,231	10/28/2003	Michael D. Eggiman	WD0111	5330

7590 06/16/2004

Terence P. O'Brien
Wilson Sporting Goods Co.
8700 W. Bryn Mawr Avenue
Chicago, IL 60631

EXAMINER	
GRAHAM, MARK S	

ART UNIT	PAPER NUMBER
3711	

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/695,231	EGGIMAN ET AL.	
	Examiner	Art Unit	
	Mark S. Graham	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *58-63,69-73 and 108-135* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *58-63, 69-73, 108-135* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 58-61, 108-111, 118, 122-125, and 132 are rejected under 35 U.S.C. 103(a) as being unpatentable over Filice in view of Chen.

Filice discloses the claimed method with the exception of the use of a composite handle. However, as disclosed by Chen it is known in the art to use such. It would have been obvious to one of ordinary skill in the art to have used such to from Filice's handle as well to provide a lighter, stronger handle. Absent a showing of unexpected results, the exact length of the connection zone would obviously have been up to the ordinarily skilled artisan depending on strength vs. flexibility considerations.

Claims 62, 63, 69-73, 112, 113, 126, and 127 are rejected under 35 U.S.C. 103(a) as being unpatentable over Filice in view of Chen and Feeney '655 (Feeney).

Filice discloses the claimed method with the exception of the use of a composite handle. However, as disclosed by Chen it is known in the art to use such. It would have been obvious to one of ordinary skill in the art to have used such to from Filice's handle as well to provide a lighter, stronger handle as explained above. Chen does not specifically discuss using multiple fiber layers but he states that various known methods of forming composites may be utilized. As disclosed by Feeney it is known in the art to use multiple plies of various angulatures and sizes to form composite bat handles. It would have been obvious to one of ordinary skill in the art to have formed Chen's

composite handle member in the same manner to help specifically tailor it to the batter's desires.

Claims 119, 120, 133, and 134 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 108 and 122 above, and further in view of Lanctot. Claims 119, 120, 133, and 134 are obviated for the reasons explained above with the exception of the weighted plug. However, as disclosed by Lanctot such are known in the art. It would have been obvious to one of ordinary skill in the art to have included one in Filice's bat for the reasons espoused by Lanctot. Lanctot does not disclose the exact length and weight of the plug but absent a showing of unexpected results such would obviously have been up to the ordinarily skilled artisan depending on the weight and balance characteristics desired by the particular batter.

Claims 121 and 135 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 108 and 122 above, and further in view of Eggiman '398 (Eggiman). Claims 121 and 135 are obviated for the reasons explained above with the exception of the insert. However, as disclosed by Eggiman such are known in the art. It would have been obvious to one of ordinary skill in the art to have included one in Filice's bat for the reasons espoused by Eggiman.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 114-117 and 128-131 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,702,698. Although the conflicting claims are not identical, they are not patentably distinct from each other because removal of the additionally claimed elements with their corresponding loss of function would have been obvious to one of ordinary skill in the art.

Chohan, Tanikawa, Cook, Volpe, and Tribble have been cited for interest because they disclose similar bats.

Any inquiry concerning this communication should be directed to Mark S. Graham at telephone number 703-308-1355.

MSG
6/12/04

Mark S. Graham
Primary Examiner